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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/292,444 | 04/15/1999 | CARY LEE BATES | RO998-222 | 3572 |

7590 07/08/2005

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EXAMINER

SINGH, RACHNA

ART UNIT PAPER NUMBER

2176

DATE MAILED: 07/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/292,444

Applicant(s)

BATES ET AL.

Examiner

Rachna Singh

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12-14 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-14, 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

RD

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| Application/Control Number: 09/292444 | Page 2 |
| Art Unit: 2176 | |

DETAILED ACTION

1. This action is responsive to communications: Request for Reconsideration filed on 4/20/05.
2. Claims 1-10, 12-14, and 16-17 are pending in the case. Claims 1, 10, and 13 are independent claims.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-3, 6, 10, 12-14, and 16-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Stork et al., US Patent 5,781,914, 7/1998.

In reference to claims 1 and 17, Stork discloses a method in which an electronic document can be converted into a hardcopy document from a hypertext document while encoding hypertext link information (compare to ***“computer-implemented method for***

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| Application/Control Number: 09/292444 | Page 3 |
| Art Unit: 2176 | |

identifying hypertext links in document printouts"). See column 1, lines 5-10. The hypertext document is scanned to identify links (compare to **"scanning a document to be printed and identifying local hypertext links within the document"**). See column 9, lines 9-10. Stork teaches that the encoded information includes location information such as the line number in order to identify the area of the hyperlink (compare to **"computing and storing a page location of each identified local hypertext link within the document"**). See column 5, lines 1-30. Stork teaches that once the location of the encoded link information has been identified, the machine-readable information is recognized and decoded to determine the hypertext link information contained therein. Once the encoded information has been decoded and specific active regions in the plain text portion of the document identified, the hyperlink information is associated with the active words and or objects and processing is performed to create the hypertext document such that the selection of the marked word causes that portion of the document or other documents to be retrieved based on the resource locator within the link information. See columns 5, lines 60-67 and column 6, lines 1-34. Stork further discloses displaying the hypertext document image on a screen. The hardcopy document that results contains hypertext link information in machine-readable format to enable conversion back into a hypertext document format. Thus, the link information will be available to the user to enable a reversal back into hypertext information. See column 8, lines 30-37. Compare to **"sequentially checking printable objects to identify each printable object within a hypertext anchor tag; and rendering each identified printable object within said hypertext anchor tag with a predefined indication of the hypertext link including printing a**

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| Application/Control Number: 09/292444 | Page 4 |
| Art Unit: 2176 | |

corresponding uniform resource locator (URL) for each external hypertext link”.

Stork does not employ the term, “anchor tag”; however, he does disclose identifying each printable object within a hypertext anchor tag when he teaches decoding the hypertext link information and retrieving the document based on the resource locator within the link information because the endpoints of hyperlinks must be identified in order to describe the hyperlinks. See columns 5-8.

In reference to claim 2 and 6, Stork discloses that a hypertext link can be linked to information within the document or an external document. See Stork, column 4, lines 39-41. Stork teaches encoding the links with the actual path information. See column 5, lines 25-30. The path information is encoded with the link while rendering the printable objects.

In reference to claim 3, Stork discloses identifying the location of the hypertext link by line number. See column 5, lines 5-25. Stork discloses printing out a hardcopy identifying the page number for an internal link to identify the location of the related hyperlink region with a line number.

Claim 10 is rejected under the same rationale used to reject claim 1 above.

In reference to claim 12, Stork discloses identifying the location of the hypertext link by line number. See column 5, lines 5-25.

Claim 13 is rejected under the same rationale used to reject claim 1 above.

Claim 14 is rejected under the same rationale used to reject claim 3 above.

Claim 16 is rejected under the same rationale used to reject claim 3 above.

Claim Rejections - 35 USC § 103

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| Application/Control Number: 09/292444 | Page 5 |
| Art Unit: 2176 | |

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4, 5, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stork et al., US Patent 5,781,914, 7/1998 in view of Microsoft Word Tutorial, "Microsoft Word Basic Features". <http://baycongroup.com/wlesson0.htm>, Microsoft Word 1997.

In reference to claims 4, 5, and 8, it was notoriously well known in the art at the time the invention was made to modify text to be displayed in various formats such as superscript form or bold form. See Microsoft Word Tutorial, pages 3-4. It would have been obvious to one of ordinary skill in the art of document display to modify the printable text of Stork to be represented in bold or superscript form to provide some distinction between the bolded or superscripted text and normal text.

7. Claims 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stork et al., US Patent 5,781,914, 7/1998 in view of Advanced Microsoft Word, "Footnotes and Endnotes" <http://www.utexas.edu/cc/training/handouts/wordadv/>

In reference to claim 9, it was notoriously well known in the art at the time the invention was made to display text in footnote form. See Advanced Microsoft Word, pages 3-7. It would have been obvious to one of ordinary skill in the art of document

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| Application/Control Number: 09/292444 | Page 6 |
| Art Unit: 2176 | |

display to modify the printable text of Stork to be represented in footnote form in order to provide comments on or provide a reference to a designated part of the text.

In reference to claim 7, Stork discloses encoding information consisting of actual path information (URL). See column 5, lines 25-30. It would have been obvious to one of ordinary skill in the art at the time the invention was made to display the URL for an external link since it was common to identify the path in a hyperlink. Moreover, it was notoriously well-known in the art at the time the invention was made to display text in footnote form. See Advanced Microsoft Word, pages 3-7. It would have been obvious to one of ordinary skill in the art of document display to modify the printable text of Stork to be represented in footnote form in order to provide comments on or provide a reference to a designated part of the text.

Response to Arguments

12. Applicant's arguments filed 4/20/05 have been fully considered but they are not persuasive.

Applicant argues that Stork does not enable identifying hypertext links in document printouts. Examiner respectfully disagrees. See column 1, lines 5-10 where Stork discloses the hypertext document is scanned to identify links. Stork states, ***“the present invention relates to hardcopy document to hyperdocument conversion that permits the construction of a hyperdocument complete with links from a hardcopy version of the document and vice versa.”*** Stork further states in column 2, lines 15-26, ***“The hardcopy document includes encoded link information and one or more regions designated to be active that are associated with the encoding link information. . .the hardcopy document is scanned and the scanned***

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| Application/Control Number: 09/292444 | Page 7 |
| Art Unit: 2176 | |

information is converted into an electronic version of the hardcopy document having active regions. Each active region is linked to electronic information such that selection of an active region accesses linked electronic information”.

Applicant argues there is no suggestion or means for checking printable objects to identify each printable object within a hypertext anchor tag in Stork. Applicant argues there are no teachings in Stork of rendering each printable object within said hypertext anchor tag with a predefined indication of the hypertext link; nor any suggestion for printing a corresponding URL for each external hypertext link. Examiner disagrees. Stork teaches that once the location of the encoded link information has been identified, the machine-readable information is recognized and decoded to determine the hypertext link information contained therein. Once the encoded information has been decoded and specific active regions in the plain text portion of the document identified, the hyperlink information is associated with the active words and or objects and processing is performed to create the hypertext document such that the selection of the marked word causes that portion of the document or other documents to be retrieved based on the resource locator within the link information. See columns 5, lines 60-67 and column 6, lines 1-34. Stork further discloses displaying the hypertext document image on a screen. The hardcopy document that results contains hypertext link information in machine-readable format to enable conversion back into a hypertext document format. Thus, the link information will be available to the user to enable a reversal back into hypertext information. See column 8, lines 30-37. Stork does not employ the term, “anchor tag”; however, he does disclose identifying each printable object within a hypertext anchor tag when he teaches decoding the hypertext link

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|---------------------------------------|--------|
| Application/Control Number: 09/292444 | Page 8 |
| Art Unit: 2176 | |

information and retrieving the document based on the resource locator within the link information because the endpoints of hyperlinks must be identified in order to describe the hyperlinks. See columns 5-8.

Examiner notes that the Applicant merely recites that certain claim limitations are not disclosed without ever specifically addressing the examiner's reliance on particular portions of the reference and stating why Applicant believes these portions do not teach what examiner purports them to teach.

In view of the comments above, the rejection is maintained.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachna Singh whose telephone number is 571-272-4099. The examiner can normally be reached on M-F (8:30AM-6:00PM).

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| Application/Control Number: 09/292444 | Page 9 |
| Art Unit: 2176 | |

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RS
07/05/05

William LeBashore
WILLIAM BASHORE
PRIMARY EXAMINER
7/5/2005